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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,782	09/23/2003	Daniel E. Pardella	PARD 1001-1	3297
22470	7590	09/20/2005	EXAMINER	
HAYNES BEFFEL & WOLFELD LLP P O BOX 366 HALF MOON BAY, CA 94019			DICUS, TAMRA	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/668,782	Applicant(s) PARDELLA, DANIEL E.	
	Examiner Tamra L. Dicus	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1-28-04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

The IDS is acknowledged.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-13 drawn to a security sensitive label, classified in class 428, subclass 40.1.
 - II. Claims 14-17 drawn to a method for helping to deter theft of a product classified in class 40, subclass 638.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the label of I can be used by hand writing on the label and use it as a post-it note without any application to a product, as it can be adhered to a wall.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with James Han on 08/29/05 a provisional election was made with traverse to prosecute the invention of I, claims 1-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-17 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 4 recites the limitation “the phrase security sensitive”. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,042,842 to Green et al.

Green teaches a high security label comprising a label body having inner and outer surfaces (FIG. 2); a substrate-damaging adhesive on the inner surface (16 and 14, FIG. 2 and associated text); and the outer surface comprising seller identification and theft-detering indicia

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(22, FIG. 2 and associated text, FIG. 3-6, and especially col. 3, lines 64 - col. 4, line 40, e.g. manufacturer's logo and printed symbols and incorporation of all of the above features including words or images or numbering or messages, FIG. 3-5 show machine readable bar codes). What happens if a product is stolen or what may occur is suggestive language and does not limit the claim. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. See also *In re Hutchinson*, 69 USPQ 138. The same material and structure is provided, thus claims 1-4, 8-10, and 13 are met.

Regarding claims 5-6, Green teaches a paper and polymer plastic film label body (18, FIG. 2 and associated text and col. 4, line 62).

Regarding claim 7, the adhesive is either permanent adhesive, aggressive or rubber based all of which are equivalent to "paper-substrate-damaging adhesive" (col. 3, lines 25-30).

Further to the information per claims 11-12, Green also teaches at col. 3, lines 6-10 customer or company names can be spelled out and words or images also may be contained, which is inclusive of store identification and a promotional slogan.

Green also teaches if a purchaser suspects a counterfeit label, the label indicates it is counterfeit by lack of the security graphics (col. 4, lines 1-15) (further to claims 1 and 13).

Claims 1-4, 8-10, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,732,979 to Finke et al.

Finke teaches a security label (1, FIG. 1 and associated text) and identification and a graphic such as bar-coding, stock information and warning messages that spell out, "warning"

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(col. 4, line 64-col. 5, line 30). The words alert the merchants by forming a sentence such as

“Warning...customer must purchase item if label is altered, removed, or tampered with”.

Adhesive material is secured to the back of the label (col. 4, lines 32-35). What happens if a product is stolen or what may occur is suggestive language and does not limit the claim.

Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. See also *In re Hutchinson*, 69 USPQ 138. The same material and structure is provided, thus claims 1-4, 8-10, and 13 are met.

Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,805,926 to Cote et al.

Cote teaches a security label comprising a label body of paper or plastic films (col. 4, lines 56-58) having inner and outer surfaces (FIG. 2); a substrate-damaging adhesive on the inner surface (26, FIG. 3-7 and associated text); and the outer surface comprising seller identification and theft-detering indicia (22, 20, 12, FIG. 2 and associated text, and especially col. 4, lines 5-53, e.g. company logo and product name, brand names inclusive of words, slogans, logos, and store identification. Also FIG. 2 shows machine-readable bar codes. What happens if a product is stolen or what may occur is suggestive language and does not limit the claim. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. See also *In re Hutchinson*, 69 USPQ 138. Further see col. 3, lines 37-41 to theft prevention. The same material and structure is provided, thus claims 1-4 and 8-10, and 13 are met.

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Regarding claims 5-6, Cote teaches a paper and polymer plastic film label body (col. 4, line 56-57).

Regarding claim 7, the adhesive is a pressure sensitive adhesive adhered and adjacent to a paper and is thus equivalent to "paper-substrate-damaging adhesive" (col. 4, line 58). See also FIG. 4 and associated text.

Further to the information per claims 11-12, Cote also teaches at col. 4, lines 7-10 any other information pertaining to the item or product may also be contained, which is inclusive of store identification and a promotional slogan.

References of Interest

The remaining references listed on form(s) 892 and/or 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

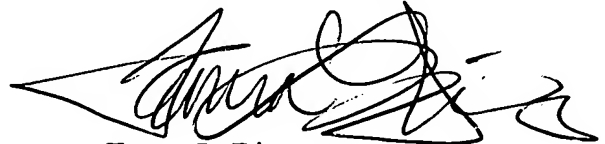
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus
Examiner
Art Unit 1774

9/8/05



RENA DYE
SUPERVISORY PATENT EXAMINER

A.U. 1774 9/12/05